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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/588,451

04/27/2007

Mamoru Sato

10084.0017

2779

22852 7590 12/26/2008  
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
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EXAMINER

KUMAR, SHAIENDRA

ART UNIT

PAPER NUMBER

1621

MAIL DATE

DELIVERY MODE

12/26/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/588,451	<b>Applicant(s)</b> SATO ET AL.	
	<b>Examiner</b> SHAILENDRA -. KUMAR	<b>Art Unit</b> 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,8 and 10-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 8 and 10-16 is/are rejected.
- 7) ☒ Claim(s) 3 and 5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/4/07</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This office action is in response to applicants' communication filed on 9/25/08.

Claims 1, 3-5, 8 and 10-16 are pending in this application. Claims 2, 6-7 and 9 have been canceled.

#### ***Information Disclosure Statement***

1. The information disclosure statement (IDS) submitted on 1/4/07 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

#### ***Claim Objections***

2. Claim 1 is objected to because of the following informalities: the definition of R401 suggests 'an unsaturated chain hydrocarbon group' It should be corrected to read "an unsaturated chain of hydrocarbon group" or "hydrocarbon group containing unsaturated chain". Appropriate correction is required.

Rejection of various claims under 35 USC 112 1<sup>st</sup> and 2<sup>nd</sup> paragraphs are hereby withdrawn, subsequent to applicants' arguments.

Rejection of claims under 35 USC 102 over Keaney et al is hereby withdrawn subsequent to applicants' submission of certified translation of the foreign priority document.

#### ***Claim Rejections - 35 USC § 102***

3. Claims 1, 4, 8, 10-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Tonomura et al(Kobe Journal of Medical sciences, 1980, abstract only).

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Tonomura et al, is teaching structurally same compound as thrombin inhibitors, especially when in the instant claim, R3 and R2 are H, R1 is methyl, R5 is substituted carboxyl, R<sup>42</sup> is H and R<sup>41</sup> is R<sup>402</sup>S(O)m, and R<sup>402</sup> is substituted hydrocarbon. Inasmuch as the reference compounds are thrombin inhibitors, they inherently teach the method of teaching arthritis, psoriasis and multiple sclerosis, absent evidence to the contrary.

See below the structure and the reference.

AU Tonomura, Shinji; Kikumoto, Ryoji; Tamao, Yoshikuni; Ohkubo, Kazuo;

Okamoto, Shosuke; Kinjo, Kiyokatsu; Hijikata, Akiko

CS Cent. Res. Lab., Mitsubishi Chem. Ind. Ltd., Japan

SO Kobe Journal of Medical Sciences (1980), 26(1), 1-9

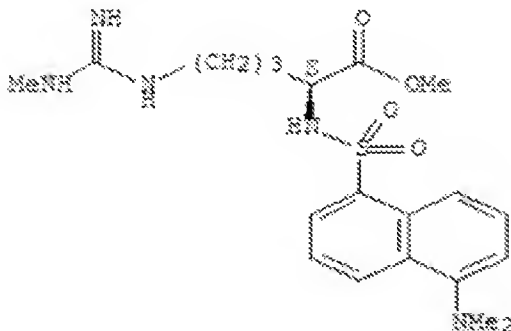
CODEN: KJMDA6; ISSN: 0023-2513

DT Journal

LA English

L1 ANSWER 1 OF 1 REGISTRY COPYRIGHT 2008 ACS on STN  
 RN 74672-32-5 REGISTRY  
 ED Entered STN: 16 Nov 1984  
 CN L-Ornithine, N2-[(5-(dimethylamino)-1-naphthalenyl)sulfonyl]-N5-[imino(methylamino)methyl]-, methyl ester (CA INDEX NAME)  
 FS STEREOSEARCH  
 MF C20 H29 N5 O4 S  
 LC STN Files: CA, CAPLUS

Absolute stereochemistry.



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4. Claims 3 and 5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHAILENDRA -. KUMAR whose telephone number is (571)272-0640. The examiner can normally be reached on Mon-Thur 8:00-5:30, Alt Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Sullivan can be reached on (571)272-0779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/SHAILENDRA - KUMAR/  
Primary Examiner, Art Unit 1621

S. Kumar  
12/19/08